

Application Serial No. 10/618,148
Customer No.: 26021
Reply to Office Action Dated 06/22/04

PATENT
86689.0006

REMARKS/ARGUMENTS:

Claims 3, 5, 7, 9, 10, 18, 20, 22 and 25-63 are canceled without prejudice. Claims 1-2 and 13 are amended. Support for the amendment can be found, e.g., at page 3, lines 2-12. No new matter is introduced. Claims 1, 2, 4, 6, 8, 11-17, 19, 21, 23 and 24 are pending in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Election/Restrictions:

Claims 1-63 are subject to a restriction requirement. Applicant confirms election of Group III, claims 1-25 for prosecution.

Rejection Under 35 U.S.C. § 112:

Claims 1-25 were rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. Applicant respectfully disagrees. The prophylaxis method is fully described in the specification such that any person skilled in the art is enabled to make and use the claimed method. See, e.g., page 4, line 15 – page 5, line 30; page 8, line 11 – page 9, line 3; and page 15, line 1 – page 16, line 15 of the specification. However, for the sole purpose of expediting the prosecution of this application, Applicant has deleted “prophylaxis” and “prevent” in claim 1, thereby overcoming the rejection.

Rejection Based on Nonstatutory Double Patenting:

Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-10 of U.S. Patent No. 6,573,248 ('248) in view of claims 1-12 of U.S. Patent 6,455,508 ('508).

Applicant submits herewith a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the rejection.

Note that, at the time the present application was filed, the invention was assigned to ICN Pharmaceuticals Switzerland Ltd., which was wholly owned by ICN Pharmaceuticals, Inc. (now Valeant Pharmaceuticals International). ICN Pharmaceuticals, Inc. was obligated to assign the

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the '248 patent, the '508 patent, and the present invention to Ribapharm Inc. pursuant to the contribution agreement entered into by ICN Pharmaceuticals, Inc. and Ribapharm Inc. on August 20, 2002. The '248 and '508 patents have been assigned to Ribapharm Inc., and the assignments have been recorded at reel No. 15044, frame No. 0925 and reel No. 15044, frame No. 0478, respectively. Currently, Valeant Pharmaceuticals International is the owner of 100% of Ribapharm Inc., as well as the '248 patent, the '508 patent, and the present invention.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

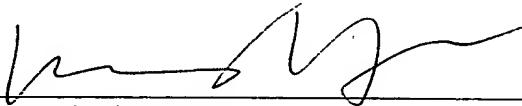
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 337-6700 to discuss the steps necessary for placing the application in condition for allowance.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,
HOGAN & HARTSON L.L.P.

Date: November 22, 2004

By:



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